

REMARKS

This Amendment After Final is submitted in response to the Office Action dated June 3, 2004. In the Office Action, the Patent Office rejected Claims 1-18 under 35 U.S.C. §103(a) as being obvious over *Greco et al.* (U.S. Patent Pub. No. 2002/0120680 A1).

By the present Amendment, Applicant amended Claims 1, 2, 5-10 and 12-14 and submits that the amendments to the claims overcome the rejection by the Patent Office for the reasons that follow and place the application in condition for allowance.

With respect to the rejection of Claims 1-18 under 35 U.S.C. §103(a) as being obvious over *Greco et al.*, Applicant submits that this rejection has been overcome in view of the amended claims and for the reasons that follow.

In the Office Action, the Patent Office asserts:

Greco et al. teach a method and system for providing electronic document services, comprising:

As per claims 1 and 12,
providing a database of information accessible by a user wherein the database of information includes information such as requirements to effectuate delivery of a special mailing, documents and addresses [0012]-[0014];

selecting a type of communication by one of the users [0062]; [0084];

Independent Claim 1, as amended, requires a database which is remote with respect to the computer wherein the database includes the communication wherein the communication in the database is selected via the computer and further wherein the communication is automatically prepared in compliance with the requirements of the delivery by the special service and automatically mailed by the special service via the computer accessible site.

Independent Claim 12, as amended, requires the step of providing a database which is remote with respect to the user wherein the database includes requirements to effectuate delivery of the communication by the special service, a plurality of communications, and addresses. Further, Claim 12 requires the step of selecting one of the plurality of communications in the database via the computer-accessible site. Moreover, Claim 12 requires the steps of automatically mailing the communication by the special service based on the requirements to effectuate the delivery of the communication by the special service and automatically paying the fees.

Contrary to the assertions of the Patent Office, Greco et al. merely teach that "the system provides a graphical user

interface, such as a toolbar, that offers a unique and novel way to access and deploy various document services." Additionally, *Greco et al.* teach that the toolbar may reside as an image directly within one or more of the borders of the visual graphic user interface (GUI) of any type of document preparation computer software application (e.g., Microsoft's Word, Excel, or PowerPoint, Corel's WordPerfect, Lotus's WordPro, Adobe's Acrobat, Quicken's QuickBooks, etc.)" Further, *Greco et al.* teach that "the system activates a graphical user interface within the document preparation software application, contacts a server to identify available document services, and configures the graphical user interface based on the available document services." Moreover, *Greco et al.* teach that "the system detects selection of one of the available document services and provides the document from the document preparation software application to one or more service providers for performance of the selected document service."

Nowhere do *Greco et al.* teach or suggest a database which is remote with respect to the computer wherein the database includes the communication wherein the communication in the database is selected via the computer as required by Claim 1.

Nowhere do *Greco et al.* teach or suggest the communication which is automatically prepared in compliance with the requirements of the delivery by the special service and automatically mailed by the special service via the computer accessible site as required by Claim 1.

Further, nowhere do *Greco et al.* teach or suggest the step of providing a database which is remote with respect to the user wherein the database includes requirements to effectuate the delivery of the communication by the special service, the communication, and addresses as required by Claim 12. Further, nowhere do *Greco et al.* teach or suggest the step of selecting the communication in the database via the computer-accessible site as required by Claim 12. Moreover, nowhere do *Greco et al.* teach or suggest a method having the steps of automatically mailing the communication by the special service based on the requirements to effectuate the delivery of the communication by the special service and automatically paying the fees as required by Claim 12.

On the contrary, *Greco et al.* merely teach that "the graphical user interface is implemented within a document preparation application used to create the document." Further, *Greco et al.* teach that "the document preparation

software 320 may include conventional word processing software, such as Microsoft Word, Corel WordPerfect, and Lotus WordPro; spreadsheet software, such as Microsoft Excel; financial analysis software, such as Quicken Quickbooks; and/or other types of software, such as Microsoft PowerPoint and Adobe Acrobat." Still further, *Greco et al.* teach that "the document the user is currently viewing via the graphical user interface of the document preparation software 320 may be automatically, securely, and electronically provided to the service provider 130. Furthermore, *Greco et al.* teach that the graphical user interface "provides a document created by the document preparation application to one or more service providers for performance of the document service corresponding to the selected graphical selectable object."

Moreover, with respect to the rejection of Claims 1 and 12 under 35 U.S.C. §103(a), one of ordinary skill in the art at the time of Applicant's invention would never have been motivated to modify *Greco et al.* in the manner suggested by the Patent Office in formulating the rejection of the claims under 35 U.S.C. §103(a). It is submitted that the question under §103 is whether the art would suggest the claimed

invention to one of ordinary skill in this art. In re Simon, 461 F.2d 1387, 174 USPQ 114 (CCPA 1972).

That elements, even distinguishing elements, are disclosed in the art is alone insufficient. It is common to find elements somewhere in the art. Moreover, most if not all elements perform their ordained and expected functions. The test is whether the invention as a whole, in light of the teaching of the reference in its entirety, would have been obvious to one of ordinary skill in the art at the time the invention was made. Connell v. Sears, Roebuck & Co., 722 F.2d 1542, 220 USPQ 193 (Fed. Cir. 1983).

It is insufficient that the art disclosed components of Applicant's invention, either separately or used in other combinations. A teaching, suggestion, or incentive must exist to make the combination made by Applicant. Interconnect Planning Corp. v. Feil, 774 F.2d 1132, 1143, 227 USPQ 543, 551 (Fed. Cir. 1988).

With the analysis of the deficiencies of *Greco et al.* in mind, as enumerated above, no reason or suggestion in the evidence of record exists why one of ordinary skill in the art at the time of Applicant's invention would have been led to modify *Greco et al.* in the manner suggested by the Patent

Office in formulating the rejection under 35 U.S.C. §103(a). Even assuming that one having ordinary skill in the art could somehow have modified *Greco et al.*, the reference still lacks the critical features and steps, positively recited in Claims 1 and 12, respectively.

More specifically, nowhere do *Greco et al.* teach or suggest a database which is remote with respect to the computer wherein the database includes the communication wherein the communication in the database is selected via the computer as required by Claim 1. Further, nowhere do *Greco et al.* teach or suggest the communication which is automatically prepared in compliance with the requirements of the delivery by the special service and automatically mailed by the special service via the computer accessible site as required by Claim 1. Still further, nowhere do *Greco et al.* teach or suggest the steps of providing a database which is remote with respect to the user wherein the database includes the communication and selecting the communication in the database via the computer-accessible site as required by Claim 12. Moreover, nowhere do *Greco et al.* teach or suggest the steps of automatically mailing the communication by the special service based on the requirements to effectuate the delivery of the

communication by the special service and automatically paying the fees as required by Claim 12.

Accordingly, the rejection of Claims 1 and 12 under 35 U.S.C. §103(a) has been overcome and should be withdrawn. Notice to that effect is requested.

In view of the foregoing remarks and amendments, Applicant respectfully submits that the rejection of Claims 1-18 under 35 U.S.C. §103(a) has been overcome and should be withdrawn. Notice to that effect is requested.

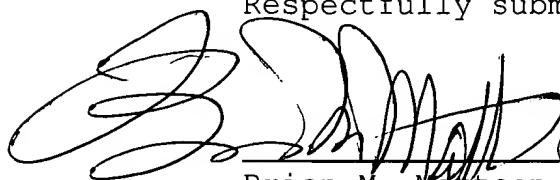
Claims 2-11 depend from independent Claim 1; and Claims 13-18 depend from independent Claim 12. These claims are also believed allowable since each sets forth additional structural elements and novel steps of Applicant's system and method, respectively.

In view of the foregoing remarks and amendments, Applicant respectfully submits that all of the claims in the application are in allowable form and that the application is now in condition for allowance. Further, Applicant submits that neither further search nor consideration would be necessitated by entry of this Amendment; therefore, entry of this Amendment is proper and should be effected.

If, however, any outstanding issues remain, Applicant urges the Patent Office to telephone Applicant's attorney so

that the same may be resolved and the application expedited to issue. Applicant requests the Patent Office to indicate all claims as allowable and to pass the application to issue.

Respectfully submitted,



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CERTIFICATE OF MAILING

I hereby certify that this **Amendment After Final** is being deposited with the United States Postal Service as First Class Mail in an envelope addressed to: Mail Stop Non-Fee Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on July 26, 2004.



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